

**R E M A R K S**

- Claims **1 – 57 and 59 – 64** are currently pending in the present application.
- Of the pending claims, claims **1, 56 – 60, 62, and 63** are independent.
- Claim **35, 57, and 59 – 64** have been cancelled herein.
- Claim **1** has been amended to include the feature of claim **35**.
- Claims **65 – 74** have been added herein.

**1. Section 101 and Section 112, second paragraph, Rejections**

Applicants gratefully acknowledge the withdrawal of the §101 rejection from the previous Office Action. Applicants also gratefully acknowledge what appears to be the withdrawal of the §112, second paragraph, rejection. Although Examiner did not explicitly state in the present Office Action that the latter rejection of claim **63** has been withdrawn, Applicants understand this to be the case since the rejection has not been maintained in the present Office Action.

**2. Objection to Specification**

The specification has been objected to as not having antecedent basis for the terms “means for receiving”, “means for identifying”, and “means for determining.” Applicants respectfully traverse this objection. This objection and each of the means-plus-functions limitations recited are the limitations of pending claim **63**.

Examiner has stated that although “applicant has described in the arguments what is meant by the means plus function terms but did not amend the specification. This helps the examiner and the record, but it does not help the future reader of the patent.” The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381, 53

USPQ2d 1225, 1230 (Fed. Cir. 1999). There is no requirement that any particular language be used in the specification to link the structure to the means plus function limitations of the claims.

In other words, as long as one of ordinary skill in the art would understand that the structure described in the specification will perform the recited function, the claims are not indefinite and the description is sufficient to satisfy the written description requirement of the second paragraph of §112. For example, in Atmel, the Federal Circuit held that incorporation by reference from a non-patent document a description of a particular high voltage generating circuit was sufficient description of a structure for the claim limitation of a "high voltage generating means".

It is true that if means-plus-function language is utilized in a claim, applicant must set forth in the specification adequate disclosure showing what is meant by that language. If applicant fails to set forth adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. In Re Donaldson Co., 16 F.3d 1189 (Fed. Cir. 1994; en banc). Since Examiner has not maintained the §112, second paragraph, rejection of claim 63 from the previous Office Action, it is Applicants' understanding that Examiner has been persuaded that the specification describes the means-plus-function limitations of claim 63 with sufficient clarity to satisfy the requirement that the structure corresponding to the functions set forth in claim 63 is described sufficiently to satisfy the requirement of the second paragraph of §112.

In addition to the structure being sufficiently described in the specification, the structure must correspond to the function of the means-plus-function claim elements with sufficient clarity that would allow one of ordinary skill in the art to understand the link. To this point, the Federal Circuit has held that "structure disclosed in the specification is 'corresponding' structure only if the specification **or prosecution history** clearly links or associates that structure to the function recited in the claim." B. Braun Medical Inc. v. Abbott Laboratories, Inc., 124 F.3d 1419 (Fed. Cir. 1997). As Examiner has acknowledged, Applicants have (in the Response to the Office Action mailed December 20, 2002) recited explicitly what exemplary structures described in the specification correspond to each of the functions recited in claim 63. Accordingly, the prosecution history clearly links exemplary structure to the function recited in the claims and the requirements of obtaining the benefits of §112, paragraph 6, have been satisfied. Applicants also respectfully submit that, even if the prosecution history had not explicitly articulated such links,

the description of the specification is sufficient for one of ordinary skill in the art to understand the link between the exemplary structures pointed out by Applicants and other structures in the specification or equivalents thereof that correspond to the functions recited in claim 63.

Again, no requirement has been set out by the Federal Circuit, rule, or statute that any particular language be used in the specification to establish that a structure correspond to a function in a means-plus-function claim. All that is required is that one of ordinary skill in the art would have understood the link, which is true for the present Application. Since the §112, second paragraph, rejection of claim 63 has not been maintained, it appears that Examiner agrees that one of ordinary skill in the art would understand the structures that correspond to the respective functions recited in claim 63. Thus, the specification as filed is sufficient.

Finally, since claim 63 has been cancelled herein, and the objection to the specification is based on this claim, Applicants respectfully submit that the objection to the specification is now moot.

### **3. Allowable Subject Matter, Amended Claims, and Newly Added Claims**

Applicants gratefully acknowledge Examiner's statement that the subject matter of claims 35 – 42, 44, 51, and 55 – 56 comprises allowable subject matter and that these claims would be allowable if rewritten into independent form, including all of the limitations of the base claim and any intervening claims. Page 4, ¶5 of Paper No. 6.

Claim 1 has been amended herein to recite the limitations of claim 35 as well as each of the previously recited limitations. Since claim 35 was directly dependent from claim 1, no limitations of any intervening claims need be incorporated. Claim 35 has been cancelled herein since its limitations are now recited in claim 1. Claims 36 – 42, 44, 51, 55 and 56 either did originally or have been amended to depend from claim 1. Claim 1 now recites that the terms of the subscription “include a penalty to be assessed against the customer if the customer violates one or more terms of the subscription” (the feature of the now cancelled claim 35). Thus, claims 36 – 42, 44, 51, 55 and 56 each include this feature as well. Since Examiner has stated that this feature constitutes allowable subject matter, Applicants respectfully submit that claims 36 – 42, 44, 51, 55, and 56 are each allowable for the same reasons as claim 35.

Newly presented claim 65 is an independent claim that recites each of the features of claim 1 (in the form before the present amendment of claim 1) as well as the feature of claim 41 that recites “wherein determining terms of a subscription further includes: presenting the customer with at least a first proposed term; receiving at least a second proposed term from the customer; and establishing terms of the subscription based on the at least first proposed term and the at least second proposed term.” Examiner has stated that this feature of claim 41 constitutes allowable subject matter and that claim 41 would be allowable if it were written in independent form that includes all the features of any intervening claims. Since claim 41 was directly dependent from claim 1, and new claim 65 comprises a method that includes each of the features of claim 1 (as before the present amendment) and claim 41, Applicants respectfully submit that claim 65 is in form for allowance.

Newly presented claim 66 is a dependent claim, dependent from claim 65, and includes the same feature as claim 42 (which is dependent from claim 41). Accordingly, since claim 66 includes each of the features of claim 65 (including the feature indicated as constituting allowable subject matter), Applicants respectfully submit that claim 66 is in form for allowance.

Newly presented claim 67 is an independent claim that recites each of the features of claim 1 (in the form before the present amendment of claim 1) as well as the feature of claim 55 that recites “receiving a modification request; and modifying terms of the subscription if the modification request is for a permitted modification.” Examiner has stated that this feature of claim 55 constitutes allowable subject matter and that claim 55 would be allowable if it were written in independent form that includes all the features of any intervening claims. Since claim 55 was directly dependent from claim 1, and new claim 67 comprises a method that includes each of the features of claim 1 (as before the present amendment) and claim 55, Applicants respectfully submit that claim 67 is in form for allowance.

Newly presented claim 68 is a dependent claim, dependent from claim 67, and includes the same feature as claim 56 (which is dependent from claim 55). Accordingly, since claim 68 includes each of the features of claim 67 (including the feature indicated as constituting allowable subject matter), Applicants respectfully submit that claim 68 is in form for allowance.

Newly presented claim 69 is an independent apparatus claim directed to an apparatus operable to perform the method of claim 1.

Newly presented claim **70** is an independent article of manufacture claim directed to a computer readable medium that is encoded with instructions for directing a processor to perform the method of claim **1**.

Newly presented claim **71** is an independent apparatus claim directed to an apparatus operable to perform the method of claim **65**.

Newly presented claim **72** is an independent article of manufacture claim directed to a computer readable medium that is encoded with instructions for directing a processor to perform the method of claim **65**.

Newly presented claim **73** is an independent apparatus claim directed to an apparatus operable to perform the method of claim **67**.

Newly presented claim **74** is an independent article of manufacture claim directed to a computer readable medium that is encoded with instructions for directing a processor to perform the method of claim **67**.

Each of the newly added independent claims **69 – 74** includes a feature that Examiner indicated was allowable over the prior art. No further search is necessitated by the addition of this claim. Thus, Applicants respectfully submit that each of independent claims **69 – 74** is in condition for allowance.

#### **4. Section 102 Rejection**

Claims **1 – 34, 43, 45 – 50, 52 – 54, 57, and 59 – 64** stand rejected under 35 U.S.C. §102(b) as being anticipated by Green et al.

Claims **1 – 34, 43, 45 – 50, and 52 – 54** now each include the “penalty” feature of now-cancelled claim **35**, which Examiner stated constituted allowable subject matter. Accordingly, Applicants respectfully submit that claims **1 – 34, 43, 45 – 50, and 52 – 54** are allowable for the same reasons as claim **35**.

Claims **57 and 59 – 64** have been cancelled herein. Accordingly, the rejection of claims **57 and 59 – 64** is now moot. Applicants do not agree with Examiner’s characterization of Green et al. or the assertion that Green et al. anticipates each of the limitations of claims **57 and 59 – 64**. Applicants have cancelled these claims herein solely to expedite allowance of the remaining

claims and intend to pursue the subject matter of claims **57 and 59 – 64** in a continuing application.

**CONCLUSION AND PETITION FOR EXTENSION OF TIME**

It is submitted all of the pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at [mfincham@walkerdigital.com](mailto:mfincham@walkerdigital.com).

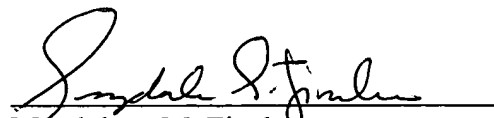
**Petition for Extension of Time to Respond**

Applicants do not believe any extension of time with which to respond to the Office Action is necessary. If a fee for an extension of time should be due, however, please charge such fee to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

September 15, 2003  
Date

Respectfully submitted,



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